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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,799	10/31/2003	Jeffrey R. Powers	056409-5095	1151

9629 7590 11/16/2005

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EXAMINER

OMGBA, ESSAMA

ART UNIT	PAPER NUMBER
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3726

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/697,799	Applicant(s) POWERS ET AL.	
	Examiner Essama Omgba	Art Unit 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-16, 19 and 20 is/are rejected.
- 7) ☒ Claim(s) 7, 17 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/29/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 8-10, 15, 16 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Korte (US Patent 3,377,903) or Pratorius (US Patent 3,490,329).

With regards to claims 1-3 and 8-10, Korte discloses a fixing assembly 7 comprising a fixing 10 adapted for being mounted to a workpiece, and a disc-shaped deformable piece 8 secured to the fixing and being adapted for engaging an inner wall of a barrel of a fastener driving tool, the disc-shaped piece has a height and a width, the height being less than the width, the disc-shaped piece including a substantially flat upper surface, see column 2, lines 54-72, column 3, lines 1-14 and figures 1, 2 5 and 6. Likewise Pratorius discloses a fixing assembly 2' comprising a fixing (reduced diameter portions between the flanges or the bottom flange with the attached reduced diameter portion, fig. 5) adapted for being mounted to a workpiece, and a disc-shaped deformable piece (flange parts, fig. 5) secured to the fixing and being adapted for engaging an inner wall of a barrel of a fastener driving tool, the disc-shaped piece has a height and a width, the height being less than the width, the disc-shaped piece including a substantially flat upper surface, see column 2, lines 71-72, column 3, lines 1-6 and figure 5.

For claim 15, see column 3, lines 2-3 of Pratorius.

For claim 16, see figures 2 and 3 and column 2, lines 28-34 of Korte.

For claim 20, see figure 2 of Korte.

3. Claims 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Pratorius.

Pratorius discloses a method of attaching a fixing to a workpiece using a fastener-driving tool having a firing chamber having a barrel with an inner wall for discharging fasteners from a nose piece of the fastener-driving tool, wherein a resilient member (upper and middle flanges with adjoining reduced diameter portion in figure 5) is provided on the fixing (bottom flange with adjacent reduced diameter portion in figure 5), securing the resilient member to the inner wall of the barrel at the nosepiece of the tool (figure 5), advancing the fastener 1 into the firing chamber and driving the fastener into the fixing, thereby securing the fixing to the workpiece, the resilient member frictionally engaging the inner wall of the barrel, see column 1, lines 45-54, column 2, lines 71-72, column 3, lines 1-6 and figure 5. Applicant should note that it is inherent that the fixing of Pratorius will be disposed on the workpiece.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 12-14 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pratorius.

With regards to claims 12-14, Pratorius discloses a fixing assembly as shown above. Although Pratorius does not disclose the fixing being a washer or a clip or having a non-circular shape, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the fixing of Pratorius could be used as a washer or clip and could be of any shape.

For claim 19, having the first portion of the resilient member attached to a top surface of the fixing with an adhesive is an obvious matter of design choice versus the attachment disclosed by Pratorius.

Allowable Subject Matter

6. Claims 7, 17 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments with respect to claims 1-6, 8-16, 19 and 20 have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Essama Omgba whose telephone number is (571) 272-4532. The examiner can normally be reached on M-F 9-6:30, 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Essama Omgba
Primary Examiner
Art Unit 3726